

UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF GEORGIA
ATLANTA DIVISION

OMEGA PATENTS, LLC,
a Georgia limited liability company,

Plaintiff,

v.

BAYERISCHE MOTOREN WERKE
AG, a Foreign company, and BMW OF
NORTH AMERICA, LLC,

Defendants.

Case No. 1:20-cv-01907-SDG

**DEFENDANT'S NOTICE OF FILING OF
PETITION FOR *INTER PARTES* REVIEW**

Defendant BMW of North America, LLC (“BMWNA”) hereby notifies the Court that, on November 13, 2020, BMWNA filed a petition for *Inter Partes* Review (“IPR”) of U.S. Patent No. 9,458,814 (“the ’814 patent”) with the Patent Trials and Appeals Board (“PTAB”) at the U.S. Patent and Trademark Office (“PTO”) in accordance with 35 U.S.C. §§ 311-319 and 37 C.F.R. § 42.100 *et seq.*

The ’814 patent is the only patent asserted by Plaintiff Omega Patents, LLC (“Omega”) in this case. The ’814 patent has 31 total claims. Omega has asserted “at least claim 1” or “one or more” claims of the ’814 patent. *See* Dkt. 1 (“Complaint”) at ¶ 15, 22. In the petition for IPR of the ’814 patent, BMWNA

requested that all claims of the '814 patent (claims 1-31) be cancelled as invalid and unpatentable under 35 U.S.C. § 103. The IPR proceeding has been assigned Trial No. IPR2021-00181. Thus, all the claims Omega could possibly assert are under review.

If the Board determines that the patent claims at issue qualify for the IPR procedure, and if the Board determines that “there is reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition,” then the Board will institute the IPR proceeding. *See* 35 U.S.C. § 314. The Board is required to determine whether to institute IPR proceedings within six months of the Notice of Filing Date (approximately May 2021). *See* 35 U.S.C. §§ 313, 314.

Now that an IPR petition has been filed addressing all claims of the '814 patent asserted in this case, BMWNA plans to file a motion to stay this litigation pending the IPR of the '814 patent.

Respectfully submitted,

Dated: November 23, 2020

/s/ Kara A. Specht
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*Attorneys for Defendant BMW of North
America, LLC*

CERTIFICATE OF SERVICE

Counsel for Defendant BMW of North America, LLC hereby certifies that on November 23, 2020, the foregoing Defendant BMW of North America, LLC's Notice of Filing of Petition for *Inter Partes* Review was filed electronically with the Clerk of the Court using the CM/ECF system, which will automatically send notification of such filing to all attorneys of record.

Pursuant to Local Rule 7.1(D), counsel for Defendant BMW of North America, LLC certifies that the foregoing was prepared in 14-point Times New Roman font and otherwise conforms to the requirements of Local Rule 5.1.

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